

REMARKS

In the Office Action, claims 1-26 were rejected. By this amendment, claims 9, 11-12 and 17-26 have been canceled, claims 10, 13 and 16 have been amended, and new claim 27 has been added. Thus, claims 1-8, 10, 13-16 and 27 are pending.

Claims 1-8, 10, 13-16 and 27

In the Office Action, claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,385,303 (“Peterson”) in view of U.S. Patent 5,594,784 (“Velius”), claim 10 was rejected under 35 U.S.C. §102(e) as being anticipated by Peterson, and claims 13-16 were rejected under 35 U.S.C. §103(a) as being obvious over Peterson in view of U.S. Patent 5,479,489 (“O’Brien”). Claims 10 and 13 have been amended to depend from claim 1, and claim 16 has been amended to depend from new claim 27, which depends from claim 1. For the reasons set forth hereinbelow, Applicants request that the rejections associated with the pending claims be withdrawn.

First, Applicants submit that independent claim 1 is nonobvious over the cited references because the cited references fail to teach or suggest each and every element of independent claim 1. See MPEP § 2143 (stating that one of the elements of a *prima facie* case of obviousness under § 103(a) is that the prior art references, either alone or in combination, must teach or suggest every limitation of the claimed invention). More particularly, Applicants submit that independent claim 1 is nonobvious over the cited references because the cited references fail to disclose, teach, or suggest, among other elements, “identifying the caller by analyzing the voice of the caller received when the caller speaks the name of the callee.”

Applicants agree with the Examiner’s determination that Peterson does not disclose

identifying the caller by analyzing the voice of the caller received when the caller speaks the name of the callee. However, Applicants respectfully disagree with the Examiner's determination that Velius discloses identifying the caller by analyzing the voice of the caller received when the caller speaks the name of the callee. Contrary to the method recited in claim 1, Applicants submit that the transparent telephone system disclosed by Velius teaches an automatic speech recognition (ASR) system 24 that determines a call destination - **not the identity of the caller** - based on the caller's utterance of the call recipient's name. *See* Velius, column 7, lines 10-24. In further contrast to the method recited in claim 1, Applicants submit that the transparent telephone system disclosed by Velius teaches indicating the identity of the caller by playing a synthesized voice message or a pre-recorded message to the call recipient - **not by analyzing the voice of the caller received when the caller speaks the name of the callee**. *See* Velius, column 7, lines 45-52.

Second, Applicants submit that independent claim 1 is nonobvious over Peterson in view of Velius because there is no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified the cited references to realize the invention of claim 1. *See* MPEP § 2143 (stating that one of the elements of a prima facie case of obviousness under § 103(a) is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings). More particularly, Applicants submit that there is no suggestion or motivation to modify the telephone system 100 of Peterson in view of the transparent telephone system of Velius to realize the method recited in independent claim 1.

Applicants submit that the combination of the cited references is an improper one because the references teach away from their combination. Applicants submit that the telephone system 100

disclosed by Peterson comprises a “conventional” telephone. *See* Peterson, Figures 1 and 2.

Applicants submit that the transparent telephone system disclosed by Velius requires a specialized station set 12 on the customer premise side of the system, and clearly shows a “conventional” telephone 42 as being outside the transparent telephone system. *See* Velius, Figure 2. Thus, Applicant submits that the combination of Peterson and Velius is improper. *See* MPEP §2145 X. D. 2. (stating that it is improper to combine references where the references teach away from their combination).

Third, Applicants submit that the rejection of independent claim 1 is a hindsight reconstruction, using Applicants’ claim as a template to reconstruct the method recited in independent claim 1 by picking and choosing isolated disclosures from the prior art. This is impermissible under the law. The teaching or suggestion to combine the references must be found in the prior art, not in the Applicants’ disclosure. Even if the references could be combined, the mere fact that they could be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143. Applicant respectfully submits that the Examiner has not shown where the prior art provides a motivation to combine the Peterson and Velius references.

Thus, for the reasons stated hereinabove, Applicants submit that independent claim 1 is nonobvious over the cited references. Applicants also submit that claims 2-8, 10, 13-16 and 27, which depend from independent claim 1, are also nonobvious over the cited references. *See* MPEP §2143.03 (stating that if an independent claim is nonobvious under §103(a), then any claim depending therefrom is nonobvious). Therefore, Applicants respectfully request that the rejections associated with these claims be withdrawn.

Marked-Up Version of Changes Made to Claims

Attached hereto is a marked-up version of the changes made to the claims by this amendment. The first page of the marked-up version is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**"

CONCLUSION

Applicants respectfully request a Notice Of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,



Robert A. Muha  
Reg. No. 44,249

KIRKPATRICK & LOCKHART, LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, Pennsylvania 15222

Telephone: (412) 355-8244  
Facsimile: (412) 355-6501  
E-mail: rmuha@kl.com

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims**

Claims 9, 11-12 and 17-26 have been canceled.

Claim 27 has been added.

The following claims have been amended as indicated.

10. (Amended) The method of claim [9] 1, further comprising routing the telephone call to a message recording system if the callee is unable to receive the telephone call.

13. (Amended) The method of claim [9] 1, further comprising creating a database containing a plurality of digital text files, wherein each of the plurality of digital text files contains identification information for a different one of a plurality of callees.

16. (Amended) The method of claim [13] 27, wherein identifying the caller includes: converting the name of the callee as spoken by the caller into a test digital text file; and individually comparing the test digital text file with the each of the plurality of digital text files in the database to identify the callee.